

REMARKS

Applicants request favorable reconsideration and withdrawal of the rejections set forth in the above-noted Office Action in view of the foregoing amendments and the following remarks.

Claims 1-25 remain pending, with claims 1, 12, 21, and 23 being independent claims. Claims 1-3, 13-15, 20, and 22-25 have been amended. Applicants submit that the amendments are merely editorial in nature, and do not include new matter.

Initially, the Office Action rejects claims 10, 19, and 20 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention.

With respect to claims 10 and 19, the Office Action asserts that the use of the term “substantially” in these claims renders these claims indefinite.

Applicants respectfully traverse this rejection. The term “substantially” has been found by the Federal Circuit to be a definite, and satisfy the requirements of 35 U.S.C. § 112. Verve, LLC v. Crane Cams, Inc., 311 F.3d 1116, 1120, 65 USPQ2d 1051, 1054 (Fed. Cir. 2002). In particular, the Federal Circuit has noted that “[e]xpressions such as ‘substantially’ are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to ‘particularly point out and distinctly claim’ the invention, 35 U.S.C. § 112, and indeed may be necessary in order to provide the inventor with the benefit of his invention.” Id. Thus, the court has made it clear that an inventor need not specifically limit his invention to precise numerical values, but rather may use the relative term “substantially,” so long as one of ordinary skill in the art would be understand the invention. In this case, Applicants submit that one of ordinary skill in the art would readily understand the recitation of the readable storage

device storing first and second indicia, or first and second membership indicia, “substantially simultaneously,” given both the context with which these features are recited in the claims, as well as given the field of the invention. Thus, Applicants submit that the Section 112 rejection with respect to claims 10 and 19 should be withdrawn.

The Office Action also rejects claims 20 in reciting a “method system.” In response, Applicants have amended this claim so as to recite merely a “system,” as is recited in claim 12, from which claim 20 depends. Accordingly, Applicants submit that the Section 112 rejection of claim 12 has been overcome and should be withdrawn.

Claims 1-25 are rejected in the Office Action under 35 U.S.C. § 102(e) as being anticipated by Bonalle et al. (U.S. Patent No. 7,119,659).

Applicants respectfully traverse this rejection for at least the following reasons.

Initially, Applicants note that the Office Action must be relying on the priority dates for Bonalle et al. in order to apply the reference under 35 U.S.C. § 102(e). The October 4, 2004 filing date of Application No. 10/711,773 (“the 773 Application”), which led to the Bonalle et al. patent, is subsequent to the June 27, 2003 filing date of the present application. Thus, filing date of the ‘773 Application is not a proper Section 102(e) date against the claims of the present applications.

Applicants further note, however, that the Bonalle et al. patent is itself a continuation-in-part application of all of the applications to which the patent claims priority. Thus, the priority applications do not necessarily include a written description of all the portions of the Bonalle et al. patent. In this regard, the portions of the disclosure in the Bonalle et al. patent that are not found in the applications to which the patent claims priority cannot be applied against the claims of the present application under 35 U.S.C. § 102(e). See MPEP § 2136.03(IV) (“For prior art

purposes, a U.S. patent or patent application publication that claims the benefit of an earlier filing date under 35 U.S.C. 120 of a prior non-provisional application would be accorded the earlier filing date as its prior art date under 35 U.S.C. 102(e), provided the earlier-filed application properly supports the subject matter relied upon in any rejection[.]” (Emphasis added)). That is, the filing dates of the priority applications of the Bonalle et al. patent cannot be used as Section 102(e) dates against the present application unless those applications contain a written description of the features of the Bonalle et al. patent that are applied against the features of the present application.

Applicants further note that the first application to which the Bonalle et al. patent claims priority, namely Application No. 10/608,792, is the present application.¹ Obviously, the filing date of the present application cannot be supportive of the Section 102(e) date for the Bonalle et al. patent. Moreover, one of the provisional applications to which the Bonalle et al. patent claims priority, namely Provisional Application No. 60,396,577, is also claimed for priority in the present application. Thus, this provisional application cannot be cited as support for the Section 102(e) date of the Bonalle et al. patent against the present application.

Applicants submit that none of the other applications to which the Bonalle et al. patent claims priority, namely Application Nos. 10/435,420²; 10/340,352³; 10/192,488⁴; and 60/304,216⁵, provides a written description for all of the features in the Bonalle et al. patent that the Office Action cites as anticipating the features of the presently claimed invention. For example, none of these applications contain a written description that is equivalent, or even

¹ The face of the Bonalle et al. patent contains a typographical error in listing this application as “10/608,742.” This error is corrected in the Certificate of Correction that was filed in the Bonalle et al. patent.

² The application has published as U.S. Patent Application Pub. No. 2004/0225602.

³ The application has published as U.S. Patent Application Pub. No. 2003/0167207.

⁴ The application has published as U.S. Patent Application Pub. No. 2004/0049451.

⁵ This application is viewable on the U.S. Patent Office’s Public PAIR system.

suggestive, of the portions of the Bonalle et al. patent that the Office Action cites as disclosing “an enrollment system” or “a universal enrollment system,” as recited in the independent claims of the present application. Further, these applications do not contain a written description that is equivalent or suggestive of the portions of the Bonalle et al. patent that the Office Action cites as disclosing supplier systems providing membership indicia, as recited in independent claims 1 and 12, or supplier systems providing unique membership numbers, as recited in independent claims 21 and 23. Thus, even if the Bonalle et al. patent itself does anticipate the features of the present invention as asserted in the Office Action (which Applicants do not necessarily concede), those portions of the patent cited in the Office Action do not have proper Section 102(e) dates against the claims of the present application.

Thus, in sum, Applicants submit that the portions of the Bonalle et al. patent that the Office Action relies on for anticipating the features of the claimed invention are not described in the priority applications (other than the present application and/or the provisional application to which the present application also claims priority) for the Bonalle et al. patent. As such, these portions of the Bonalle et al. patent do not have a Section 102(e) date prior to the filing date of the present application. Therefore, the rejection of the claims of the present application under Section 102(e) with the Bonalle et al. patent is improper, and should be withdrawn.

Applicants submit that the present application is in condition for allowance. Favorable reconsideration, withdrawal of the rejections set forth in the Office Action, and a Notice of Allowability are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. Office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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